

6-7-04
B.G.H.

Docket No.
694231/0002
(JJD)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: : **Thomas J. Shafron**

Art Unit: **2173**

Application No.: **09/429,585**

Examiner: **Brian J. Detwiler**

Filed: **October 28, 1999**

For: **METHOD OF CONTROLLING AN INTERNET BROWSER
INTERFACE AND A CONTROLLABLE BROWSER
INTERFACE**

Date: February 26, 2004

**DECLARATION UNDER 37 C.F.R. § 1.132
OF EDWARD F. SEITZ**

RECEIVED

MAR 12 2004

Technology Center 2100

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1

Sir:

I, Edward F. Seitz, declare as follows:

1. I am an employee of Yahoo! Inc., the assignee of the above-referenced patent application. My title is Engineering Director, and I am responsible for Client Kit Software Development.
2. I currently reside at 3934 Flowerland Dr., Atlanta, GA 30319.
3. I make this Declaration in support of the above-referenced currently pending application and in connection with certain rejections made by the Examiner in which the Examiner has stated that certain features of the invention are either obvious or anticipated over the prior art.
4. My educational background is as follows: I received a B.S. degree in 1987 from the University of Illinois where I majored in Aeronautical and Astronautical Engineering.



My engineering curriculum included courses involving programming and developing or using software applications to solve engineering problems.

5. After graduation I worked for Boeing Aerospace in Seattle where I performed wind tunnel testing and data analysis. I developed software, in Fortran and C, to perform test data analysis and became interested in pursuing a career in software development at this time. Independently, I studied Windows Programming Development in C, and found a position in 1990 developing Windows Applications. Since 1990, I have been working on the Microsoft Windows platform, working on several projects as a technical lead. Many of the products I have developed were made for widespread retail distribution, some of which received awards from various trade publications. In 1996, I started to work on projects that included Internet connectivity and later I started working at, and was a cofounder of, a company whose products included a web browser based on Internet Explorer. I joined Yahoo! in 1999. To date, my experience and responsibilities have focused primarily on applications that have an Internet component with a focus on widespread distribution of such programs.

6. As a result of my education and background I have substantial experience in programming of computers and computer application software, especially the programming and scripting of personal computer based applications using graphical user interfaces (GUI), such as the Windows operating system provided by Microsoft Corporation. I am also familiar, and have been familiar, with the Internet and Internet related software such as browsers, since at least 1996.

7. I believe that a person of skill in the art to which the pending application is directed, namely software for enhancing a user's experience with the Internet, in October of 1998 at the time of filing of the provisional patent application from which the above-referenced patent application claims priority, would be a person with an undergraduate degree in

Computer Science or Engineering, having taken sufficient course work to develop a proficiency in programming and/or scripting, along with several years of pertinent experience writing GUI-based applications in the Windows or Apple environment, along with a working understanding of the Internet and programs capable of operating over and with the Internet, such as commercially available Internet browsers like Explorer and Netscape.

8. I believe that my background and experience is at least that of the hypothetical person described in the preceding paragraph, and that I can read and understand related patent documents and articles, and understand and interpret them, as a person of skill in the art would.

9. One of the references cited by the Examiner is U.S. Patent No. 6,282,548 to Burner et al. I have reviewed this patent and the rejections set forth by the Examiner and disagree with the Examiner's position with respect to how a person of skill in the art would understand the use of certain terms pointed out by the Examiner in the Burner reference.

10. Specifically, the Examiner takes the position that the Burner reference, which teaches a client software program for displaying a downloadable toolbar that exists in a separate window within a Windows operating system environment, and that provides certain "metadata" information to a user while they browse the Internet, renders the claimed invention anticipated or obvious based on the Examiner's interpretation of certain terms used in the Burner reference.

11. First, the Examiner points to the use of the term "plug-in" in the Burner reference. As indicated by the attached definitions annexed hereto as Exhibits A and B, the term "plug-in" to a person of skill in the art in October of 1998 would merely connote an application program that could be added to a computer system and connected to a browser application to add functionality to the browser application, such as a media player, which was

the most common type of plug-in at the time. The fact that the client side software that generates the Burner toolbar could be implemented as a “plug-in” does not in any way teach or suggest or describe a downloadable toolbar that can be incorporated as part of the browser user interface, as are the inventions set forth in claims 53-86 of the currently pending application. The term “browser plug-in” does not mean something that is added to a browser user interface, it merely means software that runs on a client computer with a browser to add functionality to the browser. It is respectfully submitted that the Examiner is incorrect in his technical understanding of the term “plug-in” as evidenced by the attached common definitions, and has thus applied an untenable meaning to that term in the context of the Burner reference.

12. The situation is the same with respect to the term “extension”. As demonstrated by the definitions annexed hereto as Exhibits C and D, an extension is merely an item of software that is used to extend or increase the functionality of an existing software program. Thus the fact that the Burner reference teaches that the Burner toolbar which exists in a separate window can be implemented through client side software that operates as an “extension” of the browser does not describe nor teach nor suggest, nor would it motivate a person of skill in the art in October of 1998, that they should implement the Burner toolbar as incorporated as part of the browser user interface as claimed. The fact that the client side software that generates the Burner toolbar could be implemented as an “extension” does not in any way teach or suggest or describe a downloadable toolbar that can be incorporated into the browser user interface as part of the browser interface, as is the invention set forth in claims 53-86 of the currently pending application. The term “extension” does not mean something that is added to a browser user interface as part of the browser interface, it merely means software that runs on a client computer with a browser to add functionality to the browser. It is respectfully submitted that the Examiner is incorrect in his technical understanding of the term “extension”

as evidenced by the attached common definitions, and has thus applied an untenable meaning to that term in the context of the Burner reference.

13. The Examiner takes the same position in connection with the term “secondary instance window”. While the term secondary instance window is not a common term, as used in the context of the Burner patent at column 8, lines 23-37, my understanding of a “secondary instance window” is merely the opening of a second browser window using a windows-based operating system, which is how the Burner toolbar is shown and described in the preferred embodiments of the Burner patent. The fact that the described “secondary instance window” is used as an alternative to the proxy server embodiment described earlier in column 8 at lines 8 through 22 suggests that the term “secondary instance window” is just the opening of a second browser. Thus a “secondary instance window” as used in the Burner patent is just the separate window described in the Burner reference and does not in any way describe or teach or suggest that the floating toolbar of Burner should be implemented as part of the browser user interface as claimed in claims 53 to 86.

14. The same arguments set forth with respect to “plug-in” and “extension” are equally applicable to term “secondary instance window” in that all of these terms, as understood at the time that the present application was filed, merely refer to different ways of implementing the client side software that generates the separate toolbar described in the Burner reference. These terms do not, and did not at the time of filing, in any way connote the adding of a user toolbar or interface object to the browser interface as part of the browser interface as claimed.

15. An additional reason why a person of skill would not have interpreted the above-noted three terms in the way that the Examiner has is that while it is now common for browser software to include tools or Application Programming Interfaces (API’s) that permits

end-users or software developers to modify the browser interface by inserting toolbars or interface objects that are not part of the native browser software, it is my understanding that this capability was not available until after the filing of the present patent application. Thus, for this additional reason, it is respectfully submitted that the Examiner is incorrect in his technical assertions as to what the terms "plug-in", "extension", and "secondary instance window" would have actually meant to a person of ordinary skill in the art at the time the present patent application was filed. Quite simply, none of those terms could have connoted or suggested a modification of the browser interface since no browser incorporated utilities to permit such modification and in fact, it is my opinion that it is because of these closed browser software systems that Burner implemented his downloadable toolbar as a floating window outside of or overlying the browser environment as opposed to appearing as a part of the browser user interface as presently claimed. In fact, I have seen certain user group threads that are being submitted concurrently as part of an Information Disclosure Statement and which are also attached hereto as Exhibit E. A number of these threads, which are dated after October 28, 1998, are referring to a commercial embodiment of the claimed invention known as Yahoo! Companion. These threads clearly demonstrate that even after the filing date, and after the commercial deployment of an embodiment of the invention, it was not commonly recognized that toolbars could be added to the browser interface. Indeed, none of the threads actually describe a solution.

16. Additionally, the language of Burner at column 7, line 63, to column 8, line 4, suggests that Burner did not contemplate any other implementation than a separate window outside the browser interface. Nothing in the Burner patent suggests otherwise, and only the separate window embodiment is described, thus there is absolutely nothing in that reference to suggest incorporating the Burner toolbar as part of the browser interface.

17. Further, with respect to the incorporation of a search window into the user toolbar, the Examiner points to the search facility that existed in Internet Explorer 4 and as described in the Que reference that describes the Explorer search function. This functionality is starkly different from the claimed functionality of incorporating a search window into a downloadable toolbar or interface object so as to permit an end-user to conduct a search directly by entering a search term into a search term field present in the user toolbar or interface object added as part of the browser interface which would cause a search to be initiated at a predetermined site, generally and preferably the site that supplied the downloadable user toolbar as a way to instill user loyalty and promote “stickiness” of the application to the site that provides the downloadable user toolbar. The functionality described in the Internet Explorer 4 reference was for an Explorer bar, which is different from a toolbar, and which, when the “search” function was selected from the browser interface, caused an additional window pane to open up in the browser web page content display area which then displayed a dropdown menu having pre-programmed search sites that a user might wish to conduct a search at. After choosing a site from the dropdown menu a separate content display area would appear in the browser content display area which would be an HTML page provided by the selected search service provider. The user could then, in a traditional manner, enter the search term in the search term entry field of the HTML page provided by the search service, and a search would be conducted. The search result would appear in the separate window pane as an ordinary HTML page. This is starkly different from the claimed invention.

18. In claims 58, 64 and 83, the search window is incorporated into the user toolbar or appears as an interface object as part of the browser interface so that an end-user can type the search term directly into the search window and a search would be conducted at a predetermined website. This can be done, after the downloadable toolbar or interface object

was installed, without the user having to (i) click to get a dropdown menu, then (ii) select one of a group of available search services, (iii) wait for a window to open and page to load, and only then (iv) enter terms into the search window of the search page provided by the search service. I believe that a person of skill in the art in 1998 (or even now) would in no way consider the cumbersome method described in the Que reference as in any way describing or teaching or suggesting the claimed invention, which makes the search window always available regardless of where the user is navigating, and allows the user to enter a search term without any clicks or menu selection.

19. With respect to the Belfiore reference, U.S. Patent No. 6,009,459, that reference merely discloses a system that works in concert with a feature that is incorporated into the native Explorer browser that causes the browser to execute a search if the term entered into the browser address bar is not a known URL. If the term entered into the browser address bar is a known URL, the page is served as usual. If the term entered into the browser address bar returns an error, meaning the URL is not known, the browser tries to format the term into a proper URL, and if that is unsuccessful, the system will then apply a template to construct a search engine query to search for terms entered by the user at a search engine decided by the Browser provider.

20. I believe that a person of skill in November of 1998 reading the Belfiore reference would not consider the address bar of the Explorer browser to describe or teach or suggest the invention as presently claimed in claims 58, 64 and 83 which are directed to the provision of a search window that is incorporated into a downloadable toolbar or interface object and that permits search terms to be entered knowing that the search will be provided at the predetermined website from which the download was obtained. In the presently claimed invention, the user knows that when text is entered a search will be performed. The Belfiore

(Microsoft IE) system does not ensure that when text is entered a search will be performed, but rather if a term is entered that matches a URL, a new page will be served. With the presently claimed invention, when a search term is entered, a search is performed, with the user expectation that a search result will be returned. I believe that a person of skill in the art would consider this is quite different from what is taught by Belfiore, as do I.

21. Moreover, if the Explorer browser address bar of Belfiore were considered a search window as the Examiner suggests, (which I do not believe it is), then a person of skill reading Belfiore would not be motivated to add yet another search window to the browser, since a second search window would be redundant. Thus rather than motivate a person of skill to add a search window to a browser user interface via a downloadable toolbar or interface object, Belfiore, if interpreted as the Examiner interprets it, in fact teaches away from such an addition.

22. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 2/26/04

By: Edward F. Seitz
Edward F. Seitz